



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/617,234 | 07/14/2000 | Takehiro Yoshida | 35.G2619 | 5377 |
| 5514 | 7590 | 09/20/2005 | EXAMINER | |
| FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112 | | | PARK, CHAN S | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2622 | |

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/617,234

Applicant(s)

YOSHIDA, TAKEHIRO

Examiner

CHAN S. PARK

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/27/05 has been entered.

Response to Amendment

2. Applicant's amendment was received on 6/27/05, and has been entered and made of record. Currently, **claims 1-10** are pending.

Claim Objections

The following quotations of 37 § CFR 1.75(d)(1) is the basis of objection:

(d)(1) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. (See § 1.58(a)).

3. Claim 1 recites the limitation "image data" in the last line. There is insufficient antecedent basis for this limitation in the claim. Perhaps, -- the -- should be inserted in front of the limitation. Furthermore, "a start of ring-type" should be -- the start of ring-type -- in line 10 and "a transfer of ring-type" should be -- the transfer of ring-type -- in line 11.
4. With respect to claim 2, "a control operation so that, when a start of ring-type" should be -- the control operation so that, when the start of ring-type --.
5. With respect to claims 3, 5, 7, 8 and 10, arguments analogous to those presented for claim 2, are applicable.
6. Claim 4 recites the limitation "image data" in the last line. It is uncertain if this image data is referring to "the received image data". Furthermore, -- the -- should be inserted before "ring-type multiple-address processing" in lines 10 and 12.
7. With respect to claim 6, arguments analogous to those presented for claim 1, are applicable.
8. With respect to claim 9, arguments analogous to those presented for claim 4, are applicable.
9. With respect to claim 3, it recites "information indicating a nickname" in line 4. It is unclear whether this information is referring to the transmitter information or the other.

10. With respect to claim 7, arguments analogous to those presented for claim 3, are applicable.

11. It is noted that there are many insufficient antecedent basis for many limitations throughout the claims. The applicant is requested to correct these minor informalities in the claims.

The following quotations of 37 CFR 1.75(a) is the basis of objection:

(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

Claim 1 is objected to under 37 CFR 1.75(a) as failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention or discovery.

12. With respect to claim 1, "wherein the transmitter information is added as the image data" is confusing as to whether the information is also added during the transfer of ring-type reception. Perhaps, -- when the start of ring-type multiple-address transmission has been selected -- should be inserted at the end of the claim.

13. With respect to rest of independent claims, arguments analogous to those presented for claim 1, are applicable.

Specification

14. Appropriate/similar corrections are required for the specification as set forth above in the Claim Objection.

Response to Arguments

15. Applicant's arguments filed 6/27/05 have been fully considered but they are not persuasive.

In response to the applicant's arguments regarding claim 1, the applicant explains how the current invention differs from the teachings of Watanabe. Particularly, the applicant states that Watanabe fails to teach "*a controller, arranged to perform a control operation so that, when the start of ring-type multiple-address transmission has been selected, transmitter information is added, and, when the transfer of ring-type multiple-address reception has been selected, the transmitter information is not added*". Again, as previously stated in the ***Response to Arguments*** of the Office Action dated 3/22/05, examiner respectfully disagrees. Referring to col. 2, lines 33-45, the system of Watanabe includes three facsimile machines. Fax 1 represents as a repeater station for performing the repeating multiple-address transmission; Fax 2 represents a fax apparatus for requesting the repeating multiple-address transmission; and Fax 3 represents a receiving fax for receiving the repeating data from the Fax 1.

Now, when the start of ring-type multiple-address transmission is selected, that is when the fax apparatus of fig. 2 is used as the transmitter (Fax 2) for initiating the ring-type multiple-address transmission, its own telephone number is apparently added in the transmission. The telephone number is added and transmitted to the repeater station in order to (1) transmit back the transmit repeating result to the transmitting facsimile apparatus (fig. 3, S 29 & S30) and (2) register/store the telephone number of the transmitting facsimile apparatus in the repeater station (col. 6, lines 21-31 and col.

5, lines 41-46). Thus, it is clear that the transmitter information is added when the start of ring-type multiple-address transmission is selected.

Moreover, when the transfer of ring-type multiple-address reception is selected, that is when the fax apparatus of fig. 2 is used as the repeater station (fax 1), the address of the transmitter (fax 2) is apparently not added by the controller of fax 1 since it was already added by the transmitter. Examiner agrees with the applicant, in that the process performed by the current invention might be different (i.e., the transmitter information is not added by the controller of fax 2 in the transmission according to fig. 3B of the original Drawings) than what Watanabe teaches. However, this difference is not apparent in the current claim wording.

As the applicant correctly points out, Examiner previously stated that "*although Watanabe is silent as to whether or not the added phone number of the transmitting facsimile apparatus is transmitted to the final destination, it can be concluded that the repeater does not add the phone number again in the facsimile data because it is already added/included by the transmitting facsimile apparatus*". The applicant further states that "*thus, the Examiner admits that Watanabe et al. does not expressly disclose that, when a transfer of ring-type multiple-address reception has been selected, the transmitter information is not added, as required by Claim 1.*" Respectfully, this statement is not necessarily correct. Examiner's admission of transmitting or not transmitting the added phone number is irrelevant as to whether the controller of fax 1 adds the transmitter information or not. What is certain from the teachings of Watanabe

is when the fax apparatus of fig. 2 is used as the repeater station (fax 1), the address of the transmitter (fax 2) is not added by the controller of fax 1.

Therefore, Watanabe teaches the limitations presented above.

16. With respect to claims 4, 6 and 9, arguments analogous to those presented for claim 1, are applicable.

17. Applicant's amendment necessitated the following new ground(s) of rejection in this Office action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. U.S. Patent No. 5,170,428 (hereinafter Watanabe) in view of Kawasaki U.S. Patent No. 6,310,699.

18. With respect to claim 1, Watanabe discloses a communication apparatus (facsimile of fig. 2) adapted to perform ring-type multiple-address transmission (relay operation, as defined in the specification of the instant application), said apparatus comprising:

a registration unit (fig. 2, #9, column 2, lines 48-68, column 3, lines 1-4) arrange to register a sub-address signal and a communication specification so as to correspond to a memory box;

a start selector, (fig. 2, #7, column 3, lines 5-26) arranged to select a start of a ring-type multiple-address transmission;

a ring-type multiple address reception transfer selector, (fig. 2, #12 & #13, column 3, lines 27-45) arranged to select a transfer of a ring-type multiple-address reception; and

a controller, (fig. 2, #6, column 2, lines 48-68, column 3, lines 1-4) arranged to perform a control operation so that, when the start of a ring-type multiple address transmission has been selected, transmitter information is added, and when the transfer of ring-type multiple-address reception has been selected, the transmitter information is not added (refer to the arguments represented above);

wherein the communication apparatus performs the ring-type multiple address transmission/reception of image data (relay operation, as defined in the specification of the instant application).

Watanabe, however, does not disclose expressly that the transmitter information is added as the image data.

Kawasaki, the same field of endeavor of the facsimile system, discloses the method of adding the transmitter facsimile information as the image data (Abstract and col. 2, lines 39-42).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the method of adding the transmitter information as the image data of Kawasaki into the facsimile system of Watanabe.

The suggestion/motivation for doing so would have been to receive the transmitter information along with the image data.

Therefore, it would have been obvious to combine Kawasaki with Watanabe to obtain the invention as specified in claim 1.

19. With respect to claim 2, Watanabe discloses a communication apparatus (facsimile) adapted to perform ring-type multiple-address transmission, wherein said controller performs a control operation so that, when a start of ring-type multiple-address transmission has been selected, information indicating ring-type multiple-address transmission and information indicating a nickname of information to be transmitted are added as transmitter information. Watanabe discloses in column 3, lines 5-26, that the transmitter or originating unit information is added to the transmitted document. Therefore, it would be inherent that the information that is preprogrammed within the originating unit as to the unit's information, be added to a transmitted document, and that if a nickname is used to describe the unit then a nickname would be added to the transmitted information.

20. With respect to claim 3, Watanabe discloses a communication apparatus (facsimile) adapted to perform ring-type multiple-address transmission, wherein said controller performs a control operation so that, when the sub-address signal and a transfer to a predetermined address, (column 3, lines 5-26) serving as communication

specification, are registered in said registration unit so as to correspond to the memory box, if the registered sub-address signal is received, the transmitter information is added, and the received information is transferred to the predetermined address. The claim is interpreted to mean, that if a plurality of addresses is to receive a transmitted document then the transmitted information of the originating unit's information is added to the document. Watanabe discloses that the information of originating unit is added not the information of any relay units.

21. With respect to claim 5, Watanabe discloses a communication apparatus (facsimile) adapted to perform ring-type multiple-address transmission, wherein said controller performs a control operation so that, when the sub-address signal and a transfer to a predetermined address, (column 3, lines 5-26) serving as communication specification, are registered in said registration unit so as to correspond to the memory box, if the registered sub-address signal is received, the transmitter information is added, and the received information is transferred to the predetermined address. The claim is interpreted to mean, that if a plurality of addresses are to receive a transmitted document then the transmitted information of the originating unit's information is added to the document. Watanabe discloses that the information of originating unit is added not the information of any relay units.

22. With respect to claim 4, Watanabe et al. discloses a communication apparatus (facsimile) adapted to perform ring-type multiple-address transmission, said apparatus comprising:

a memory, (fig. 2, #10, column 3, lines 58-59) arranged to store received data;

a transfer unit (fig. 2, #12 & #13, column 3, lines 27-68) arranged to transfer the received data stored in said memory;

an identification unit (fig. 2, #12 & #13, column 3, lines 27-68), arranged to identify whether or not the received data is data assigned to be subjected to ring-type multiple-address processing; and

a processor (fig. 2, #6, column 2, lines 48-68, column 3, lines 1-4), arranged to cause said transfer unit to transfer the received data without adding transmitter information if the received data is data assigned to be subjected to ring-type multiple-address processing, and to cause the transfer unit to transfer the received data with the transmitter information added thereto if the received data is not data assigned to be subjected to the ring-type multiple-address processing (column 4, lines 45-55, and column 5, lines 40-45). Refer to the arguments represented above.

Watanabe, however, does not disclose expressly that the transmitter information is added as the image data.

Kawasaki, the same field of endeavor of the facsimile system, discloses the method of adding the transmitter facsimile information as the image data (Abstract and col. 2, lines 39-42).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the method of adding the transmitter information as the image data of Kawasaki into the facsimile system of Watanabe.

The suggestion/motivation for doing so would have been to receive the transmitter information along with the image data.

Therefore, it would have been obvious to combine Kawasaki with Watanabe to obtain the invention as specified in claim 4.

23. With respect to claim 6, arguments analogous to those presented for claim 1, are applicable.

24. With respect to claim 7, arguments analogous to those presented for claim 2, are applicable.

25. With respect to claim 8, arguments analogous to those presented for claim 3, are applicable.

26. With respect to claim 9, arguments analogous to those presented for claim 4, are applicable.

27. With respect to claim 10, arguments analogous to those presented for claim 5, are applicable.

Conclusion


28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

csp
September 14, 2005

Chan S. Park
Examiner
Art Unit 2622


EDWARD COLES
SUPERVISOR
10/11/05